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10/824,705	04/15/2004	Roy Schoenberg	66729/P034US/10614706	6791
29053 7590 04/15/2009 FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784				
EXAMINER				
RAPILLO, KRISTINE K				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/824,705

**Applicant(s)**

SCHOENBERG, ROY

**Examiner**

KRISTINE K. RAPILLO

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date 9/30/2004
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment submitted December 29, 2008. Claims 1 - 2, 4, 7 - 8, 13 - 14, 17, 19 - 20, 26 - 27, 32 - 33, 36, 38 are amended. Claims 3 and 22 - 23 are cancelled. Claims 39 - 41 are new. Claims 1 - 41 are pending.

***Drawings***

2. The objections to the drawings are hereby withdrawn based on the amendment submitted December 29, 2008.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13, 19, 32, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "numeric range-based variable that can accept any numeric value within a range of valid numeric values" is vague and indefinite. It is unclear as to what the numeric value is; the claim is written such that the numeric value could be any number of things (i.e. diagnosis/treatment codes, vital signs, patient identification numbers). For the purpose of examination, the Examiner has treated this limitation as a vital sign reading (i.e. blood pressure, temperature).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3626

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 - 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al., herein after Ross (U.S. Patent Number 7,076,436 B1) in view of Wheeler et al., herein after Wheeler (U.S. Publication Number 2003/0097573 A1).

In regard to claim 1 (Currently Amended), Ross teaches a data entry method comprising: in a computer-based medical record including a plurality of data fields (Figures 5, 6, and 7; column 1, lines 17 – 37 where the master patient module is equated to a computer based medical record), defining one or more data fields for which desired field data is to be acquired (Figure 5 where data fields include, but are not limited to, prescriptions, physician notes, and nurses notes); receiving, by said computer-based application, the desired field data from the data source (column 4, line 67 through column 5, line 3) where the desired data is the patient data; and, triggering, by said computer-based application, contacting said data source in possession of the desired field data in accordance with said schedule (Figure 5 and column 11, lines 13 – 19) where Ross discloses a method in which a schedule is set in which a physician must contact a patient. A schedule is interpreted as a window or time frame allotted to call.

Ross fails to teach a method comprising: automatically populating at least one of the one or more data fields with desired field data from a data source, said automatically comprising: receiving, by a computer-based application that is stored to a computer-readable medium and executing on a processor-based computer: a schedule for contacting said data source to prompt said data source for the desired field data for said at least one data field.

Wheeler teaches a method comprising: automatically populating at least one of the one or more data fields with desired field data from a data source (Wheeler: paragraphs [0130] and [0299] where Wheeler discloses that the fields/menus can be automatically filled in by the computer using information stored in cookies), said automatically comprising: receiving, by a computer-based application that is stored to a computer-readable medium and executing on a processor-based computer: a schedule for contacting said data source (disclosed by Ross Figure 5 and column 11, lines 13 – 19) to prompt said

Art Unit: 3626

data source for the desired field data for said at least one data field (Wheeler: Figures 24 and 28; paragraphs [0231], [0234], [0241], and [0245]) where Wheeler discloses the computer prompting the user for information.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method automatically populating at least one of the one or more data fields with desired field data from a data source, said automatically comprising: receiving, by a computer-based application that is stored to a computer-readable medium and executing on a processor-based computer: a schedule for contacting said data source to prompt said data source for the desired field data for said at least one data field as taught by Wheeler, within the method of Ross, with the motivation of providing a method of electronically communicating information concerning medical records such as medical history, known allergies and major medical conditions (paragraph [0230]).

In regard to claim 2 (Currently Amended), Ross and Wheeler teach the method of claim 1. Ross teaches a method further comprising updating, by said computer-based application, the computer-based medical record to include the received desired field data (column 7, lines 15 – 16; column 9, lines 23 – 31; and, column 14, lines 12 – 19).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 4 (Currently Amended), Ross and Wheeler teach the method of claim 1. Ross further teaches a method wherein the data source is a patient and the medical record defines at least a portion of the medical history of the patient (column 9, lines 16 – 31) where the patient history is entered, thus the data source is the patient.

In regard to claim 5, Ross and Wheeler teach the method of claim 1. Ross fails to teach a method wherein contacting a data source includes: authenticating the data source.

Art Unit: 3626

Wheeler teaches a method wherein contacting a data source includes: authenticating the data source (Figures 5B, 8, and 12; paragraphs [0130], [0138], and [0153]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 6, Ross and Wheeler teach the method of claim 5. Ross further teaches a method wherein authenticating the data source includes: requiring that the data source enter an electronic password (column 6 lines 50 – 64 and column 12, line 46 through column 13, line 2). Although Ross does not explicitly teach a data source (or patient) entering an electronic password, it is obvious that the same process would be used to enter the password regardless of who was entering the password. Ross fails to teach a method including receiving the electronic password.

Wheeler teaches a method including receiving the electronic password (paragraph [0148]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 7 (Currently Amended), Ross and Wheeler teach the method of claim 5. Ross fails to teach a method wherein authenticating the data source includes: requiring that the data source speak a verbal password and receiving the verbal password.

Wheeler teaches a method wherein authenticating the data source includes: requiring that the data source speak a verbal password (paragraphs [0149] and [0241]) and receiving the verbal password (paragraphs [0149] and [0241]) where Wheeler discloses verbal authentication.

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 8 (Currently Amended), Ross and Wheeler teach the method of claim 5. Ross fails to teach a method wherein authenticating the data source includes: requiring that the data source provide an authenticating digital certificate and receiving the authenticating digital certificate.

Art Unit: 3626

Wheeler teaches a method wherein authenticating the data source includes: requiring that the data source provide an authenticating digital certificate (paragraphs [0007], [0008], [0009], [0010], and [0011]) and receiving the authenticating digital certificate (paragraphs [0007], [0008], [0009], [0010], and [0011]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 9, Ross and Wheeler teach the method of claim 1. Ross fails to teach a method wherein contacting a data source includes: transmitting an email to the data source.

Wheeler teaches a method wherein contacting a data source includes: transmitting an email to the data source (Figure 57 and paragraph [0259]) where a customer can be equated to the data source (patient).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 10, Ross and Wheeler teach the method of claim 9. Ross teaches a method wherein contacting a data source further includes: providing the data source with text-based instructions concerning the desired field data (Figure 5; column 9, lines 23 – 31; column 10, lines 48 – 49; and column 11, lines 39 – 43).

In regard to claim 11, Ross and Wheeler teach the method of claim 1. Ross teaches a method wherein contacting a data source includes: telephonically contacting the data source (column 5, lines 27 – 35) where Ross discloses a telephone system which can be used for network communication. Although Ross does not explicitly teach contacting a data source via a telephone, it would be obvious that this communication could occur based on the existence of a telephone system.

In regard to claim 12, Ross and Wheeler teach the method of claim 11. Ross fails to teach a method wherein contacting a data source includes: providing the data source with speech-based instructions concerning the desired field data.

Wheeler teaches a method wherein contacting a data source includes: providing the data source with speech-based instructions concerning the desired field data (paragraphs [0213]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 13 (Currently Amended), Ross and Wheeler teach the method of claim 1. Ross further teaches a method wherein the desired field data concerns a numeric range-based variable that can accept any numeric value within a range of valid numeric values (Figure 5; column 7, lines 15 – 16; column 9, lines 23 – 31; and column 11, lines 12 – 19) where Ross discloses a method where vital signs are recorded. The Examiner interprets a range of valid numeric values to be any value read during a reading of a vital sign.

In regard to claim 14 (Currently Amended), Ross teaches a data entry method comprising: in a computer-based medical record including a plurality of data fields (Figures 5, 6, and 7; column 1, lines 17 – 37), defining one or more data fields for which desired field data is to be acquired (Figure 5), wherein the medical record defines at least a portion of the medical history of a patient (column 9, lines 15 – 31); receiving, by said computer-based application, the desired field data from the patient (column 4, lines 15 – 31); and updating, by said computer-based application, the computer-based medical record to include the received desired field data (column 7, lines 15 – 16 and column 14, lines 12 – 19). triggering, by said computer-based application, telephonically contacting the patient (Figure 5 and column 11, lines 13 – 19).

Ross fails to teach a method comprising: automatically populating at least one of the one or more data fields with desired field data from the patient, said automatically populating comprising: receiving, by a computer-based application that is stored to a computer-readable medium and executing on a



Art Unit: 3626

processor-based computer, a schedule for contacting said patient to prompt said patient for the desired field data for said at least one data field.

Wheeler teaches a method comprising: automatically populating at least one of the one or more data fields with desired field data from the patient (paragraphs [0130] and [0299]), said automatically populating comprising: receiving, by a computer-based application that is stored to a computer-readable medium and executing on a processor-based computer, a schedule for contacting said patient to prompt said patient for the desired field data for said at least one data field (Figures 24 and 28; paragraphs [0231], [0234], [0241], and [0245]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 15, Ross and Wheeler teach the method of claim 14. Ross fails to teach a method wherein telephonically contacting the patient includes: authenticating the patient.

Wheeler teaches a method wherein telephonically contacting the patient includes: authenticating the patient (Figures 5B, 8, and 12; paragraphs [0130], [0138], and [0153]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 16, Ross and Wheeler teach the method of claim 15. Ross further teaches a method wherein authenticating the patient includes: requiring that the patient enter an electronic password (column 6 lines 50 – 64 and column 12, line 46 through column 13, line 2). Ross fails to teach a method including receiving the electronic password.

Wheeler teaches a method including receiving the electronic password (paragraphs [0148] and [0149]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

Art Unit: 3626

In regard to claim 17, Ross and Wheeler teach the method of claim 15. Ross fails to teach a method wherein authenticating the patient includes: requiring that the patient speak a verbal password receiving the verbal password.

Wheeler teaches a method wherein authenticating the patient includes: requiring that the patient speak a verbal password receiving the verbal password (paragraphs [0149] and [0241]). Wheeler discloses a biometric value.

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 18, Ross and Wheeler teach the method of claim 14. Ross fails to teach a method wherein telephonically contacting the patient includes providing the patient with speech based instructions concerning the desired field data.

Wheeler teaches a method wherein contacting a patient includes: providing the patient with speech-based instructions concerning the desired field data (paragraphs [0213]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 19 (Currently Amended), Ross and Wheeler teach the method of claim 14. Ross further teaches a method wherein the desired field data concerns a numeric range-based variable that can accept any numeric value within a range of valid numeric values (Figure 5; column 7, lines 15 – 16; column 9, lines 23 – 31; and column 11, lines 12 – 19).

In regard to claim 39 (New), Ross and Wheeler teach the method of claim 1. Ross further teaches a method comprising where at least one data field for which said data source is to be contacted in accordance with said schedule (Figure 5 and column 11, lines 13 – 19). Ross fails to teach a method comprising: receiving, by the computer-based application, selection of said at least one data field for

Art Unit: 3626

which said data source is to be contacted in accordance with said schedule to prompt said data source for the desired field data.

Wheeler further teaches a method comprising: receiving, by the computer-based application, selection of said at least one data field for which said data source is to be contacted in accordance with said schedule to prompt said data source for the desired field data (Figures 24 and 28; paragraphs [0231], [0234], [0241], and [0245]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 40 (New), Ross and Wheeler teach the method of claim 14. Ross further teaches a method comprising where at least one data field for which said data source is to be contacted in accordance with said schedule (Figure 5 and column 11, lines 13 – 19). Ross fails to teach a method comprising: receiving, by the computer-based application, selection of said at least one data field for which said data source is to be contacted in accordance with said schedule to prompt said data source for the desired field data.

Wheeler further teaches a method comprising: receiving, by the computer-based application, selection of said at least one data field for which said data source is to be contacted in accordance with said schedule to prompt said data source for the desired field data (Figures 24 and 28; paragraphs [0231], [0234], [0241], and [0245]).

The motivation to combine the teachings of Ross and Wheeler is discussed in the rejection of claim 1, and incorporated herein.

Computer program product claims 20 – 38 and 40 – 41 repeat the subject matter of method claims 1 – 19 and 39 as a set of apparatus elements rather than a series of steps. As the underlying elements of claims 1 – 19 and 39 have been shown to be fully disclosed by the teachings of Ross and Wheeler in the above rejection of claims 1 – 19 and 39, it is readily apparent that the computer program

product apparatus performs these steps. As such, these limitations (20 – 38 and 40 - 41) are rejected for the same reasons given above for method claims 1 – 19 and 39, and incorporated herein.

#### ***Response to Arguments***

7. Applicant's arguments filed December 29, 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed December, 2009.

In response to the Applicant's argument, it is respectfully submitted that the Examiner has applied new passages and new citations to the amended claims. The Examiner notes that the amended limitations were not in the previously pending claims; as such, Applicant's remarks with the regard to the application of Ross and Wheeler are addressed in the above Office Action.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/Robert Morgan/  
Primary Examiner, Art Unit 3626